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16 BCS PROPERTIES, LLC

11 UNITED STATES DISTRICT COURT
12 NORTHERN DISTRICT OF CALIFORNIA

CV 16 80151 MISC

SK

14 Lile Inc.,

15 Opposer,

16 v.

17 BCS Properties, LLC,

18 Applicant.

Case No.: 91220066/91221745 (TTAB)

**MOTION TO COMPEL PRODUCTION OF
DOCUMENTS**

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Pursuant to Federal Rules of Civil Procedure 37 and 45(d)(2)(B)(i), Applicant BCS Properties, LLC ("Applicant" or "BCS Properties") hereby moves the United States District Court for the Northern District of California for an order compelling third party Raj Abhyanker P.C. ("Raj Abhyanker" or the "Firm") to produce relevant documents relating to the claimed trademark use and exclusive rights of Opposer Lile Inc. ("Lile" or "Opposer"), which have been withheld improperly on a claim of attorney-client privilege in response to a subpoena duces tecum issued on June 28, 2016 pursuant to Federal Rule of Civil Procedure 45, as incorporated into the Trademark Rules of Practice under Rule 2.116(a), 37 CFR § 2.116. The subpoenaed documents are sought in connection with consolidated trademark registration opposition proceedings pending before the Trademark Trial and Appeal Board ("TTAB") as *Lile Inc. v. BCS Properties, LLC*, TTAB Opposition Nos. 91220066/91221745 (the "TTAB Proceeding").

FACTUAL AND PROCEDURAL BACKGROUND

On March 28, 2013, BCS Properties filed with the U.S. Patent and Trademark Office ("PTO") Application Serial No. 85888764 for the mark "COLLEGE FOOTBALL PLAYOFF." Declaration of Steven P. Hollman in Support of Motion to Compel Production of Documents ("Hollman Decl.") ¶ 2, Ex. A. Opposer filed a notice of opposition to BCS Properties' Application Serial No. 85888764 on April 29, 2015. On May 1, 2013, BCS Properties also filed Application Serial No. 85919900 for the mark "COLLEGE FOOTBALL PLAYOFF & Design." *Id.* ¶ 3, Ex. B. Opposer filed a notice of opposition to BCS' Properties' Application Serial No. 85919900 on January 7, 2015. As noted above, the foregoing oppositions now are consolidated as the pending TTAB Proceeding.

Pursuant to the Board's scheduling order, BCS Properties served on Lile Applicant BCS Properties, LLC's First Set of Interrogatories to Opposer Lile Inc., dated April 20, 2015, and Applicant BCS Properties LLC's First Set of Requests for Production of Documents, Things, and Electronically Stored Information to Opposer Lile Inc. ("Applicant's Requests"), dated April 21, 2015. On May 20, 2015, Lile filed Opposer's Objections and Responses to Applicant's First Set of Document Requests ("Objections to Requests"). *Id.* ¶ 4, Ex. C.

Applicant's Requests included, *inter alia*, a Request No. 13 for "[a]ll Materials relating to

1 the preparation, filing, and prosecution of any U.S. state or federal trademark application for
 2 Opposer's Mark [Application Serial No. 86052371] or any related Mark, including any Materials
 3 concerning whether and why such filing was deemed necessary and/or desirable." *See* Obj. to
 4 Requests at 9, Hollman Decl. Ex. C. Applicant's Request No. 38 similarly sought "[a]ll Materials
 5 relating to Opposer's knowledge and/or awareness of the use, registration, and/or application for
 6 registration of Applicant's Mark, including all Materials which record, refer, or relate to
 7 Opposer's earlier knowledge of the use of Applicant's Mark and/or use by Applicant of marks
 8 comprising the words COLLEGE FOOTBALL PLAYOFF." *Id.* at 21. Despite reciting
 9 boilerplate objections that Requests Nos. 13 and 38 supposedly were "irrelevant and immaterial,"
 10 did not "bear on the facts at issue in this matter," were "not reasonably calculated to lead to the
 11 discovery of admissible evidence," sought "confidential, sensitive, and/or proprietary trade
 12 secrets, financial and other business information and documents," and/or were "overly broad and
 13 unduly burdensome," *id.* at 9, 21, Lile promised to produce any "non-privileged documents and
 14 things in its possession, custody, or control, if any, that are responsive." *Id.*

15 Applicant received Opposer's document production in response to Applicant's Requests
 16 on April 22, 2016. The entire production encompassed only 291 pages and did not include
 17 Opposer's client file from its former counsel, Raj Abhyanker P.C., related to Lile's trademark
 18 Application Serial No. 86052371. In particular, Opposer's document production offered no
 19 evidentiary support for Opposer's claimed trademark use or exclusive right to use the
 20 "CFBPLAYOFF.COM" mark, or any information regarding the factual basis for the August 30,
 21 2013 declaration of Lile's former counsel, Tanya Falleiro ("Falleiro"), supporting Application
 22 Serial No. 86052371. Hollman Decl. ¶ 18. Falleiro, who no longer is employed at Raj
 23 Abhyanker P.C. or its apparent successor law firm, LegalForce RAPC, stated in her declaration
 24 that she:

25 [B]elieves the applicant to be entitled to use such mark in
 26 commerce; to the best of his/her knowledge and belief no other
 27 person, firm, corporation, or association has the right to use the
 28 mark in commerce, either in the identical form thereof or in

1 such near resemblance thereto as to be likely, when used on
2 or in connection with the goods/services of such other person,
3 to cause confusion, or to cause mistake, or to deceive; and that
4 all statements made of his/her own knowledge are true; and
5 that all statements made on information and belief are believed
6 to be true.

7 Application Serial No. 86052371, Hollman Decl. ¶ 5, Ex. D. Falleiro's declaration statement was
8 made upon "her own knowledge," notwithstanding the prior filing of Applicant's initial
9 Applications Serial No. 85888764 (filed March 28, 2013), 85919900 (filed May 1, 2013), and
10 85919919 (filed May 1, 2013), all related to the marks "COLLEGE FOOTBALL PLAYOFF" and
11 "COLLEGE FOOTBALL PLAYOFF & Design." *Id.*

12 Seeking to understand the factual basis for Falleiro's statement, counsel for BCS
13 Properties sent an email to counsel for Opposer on June 3, 2016, inquiring whether Lile would
14 "obtain a copy of its client file on the trademark application from Raj Abhyanker, P.C., on the
15 grounds that the file is within Lile's possession, custody or control and is responsive to our
16 document request to the extent it contains the basis for Ms. Falleiro's sworn statements in her
17 declaration supporting the application." Hollman Decl. ¶ 6, Ex. E. BCS Properties' counsel also
18 inquired whether he could make arrangements with Falleiro to obtain her deposition testimony
19 directly. *Id.* Ex. E. BCS Properties' counsel made follow-up inquiries to Opposer's counsel
20 regarding its willingness and ability to obtain Lile's client file from Raj Abhyanker P.C. on June
21 9, 2016. *Id.* ¶¶ 7, 8, Ex. F, Ex. G.

22 On June 10, 2016, counsel for Opposer indicated in an email to BCS Properties' counsel
23 that Lile was "in the process of requesting the attorney file associated with [Lile's] application no.
24 86/052,371 of CFBPLAYOFF.COM" and that he would "keep [Opposer] updated on our
25 progress." Hollman Decl. ¶ 9, Ex. H. On June 10, 2016 and July 8, 2016, Opposer also made
26 small supplemental document productions in response to Applicant's Requests, neither of which
27 appears to contain documents from Lile's client file from its former counsel, Raj Abhyanker P.C.
28 *Id.* ¶ 21.

1 On June 17, 2016, counsel for Opposer again indicated in an email to BCS Properties'
2 counsel that he was "still waiting to hear back on the progress of obtaining the attorney's file, if
3 available, for the CFBPLAYOFF.COM application. We'll keep you updated." *Id.* ¶ 10, Ex. I.
4 On the same date, counsel for BCS Properties sent counsel for Opposer an email reiterating:
5 "Please let me know where we stand on the client file from Raj Abhyanker, P.C., as I intend to
6 use that file in my questioning of Lile and [its corporate designee] Mr. [Edward] Deeb." *Id.* ¶ 11,
7 Ex. J. The deposition of Lile's corporate witness, Edward Deeb ("Deeb") under Rules 30(b)(1)
8 and 30(b)(6) of the Federal Rules of Civil Procedure was scheduled at that time for June 24, 2016.
9 *Id.* ¶ 11.

10 In an email of June 20, 2016, counsel for Opposer indicated that he had contacted
11 "Christopher Civil of Raj Abhyanker PC regarding the attorney file for Lile Inc.'s Application
12 No. 86/052,371 of CFBPLAYOFF.COM. He is determining what they have and confirming next
13 steps with his supervising attorney." *Id.* ¶ 12, Ex. K. Although Opposer's counsel claimed that
14 he had "informed him of the need for the file for this Friday's deposition," *id.* Ex. K, the file was
15 not produced prior to the Rule 30(b)(6) and personal deposition of Deeb on June 24, 2016, *id.* ¶
16 19.

17 The deposition, like Lile's document production, failed to yield any evidentiary
18 substantiation for Opposer's claimed trademark use or first use of the "CFBPLAYOFF.COM"
19 mark. However, Deeb's deposition testimony appeared to raise the suggestion that some
20 evidence of use, such as Lile's website statistics, may have been lost in certain early "hacking"
21 incidents. Assuming that such spoliation of evidence occurred, the only remaining sources of
22 evidentiary information regarding Lile's use priority (if any) would seem to be Lile's client file
23 from Raj Abhyanker P.C. and Falleiro's deposition testimony. Lile has confirmed that it has no
24 other responsive documents to produce and has not identified any other witnesses. *Id.*

25 To this day, neither Lile nor its counsel has been willing or able to produce the relevant
26 client file. Nor have they identified specifically any documents withheld on the basis of a claim
27 of privilege or other protection, nor disclosed whether any non-privileged documents have been
28 withheld. *Id.* ¶ 20. Given this failure of production, BCS Properties proceeded to request the

1 same documents through a subpoena issued directly to Raj Abhyanker P.C. on June 28, 2016, of
 2 which Opposer was given notice. *Id.* ¶ 13, Ex. L. BCS also requested the deposition testimony
 3 of Falleiro through a subpoena issued directly to her on June 28, 2016, of which Opposer also was
 4 given notice. *Id.* ¶ 14, Ex. M. On July 6, 2016, Raj Abhyanker P.C. filed its Objections and
 5 Responses to Third Party Subpoena to Produce Documents, Information in a Civil Action (“Third
 6 Party Objections”). *Id.* ¶ 15, Ex. N. Filled largely with boilerplate general objections, the Third
 7 Party Objections assert that there are “no responsive, non-privileged documents” as to each and
 8 every document request propounded by BCS. *Id.* Ex. N.

9 On July 13, 2016, counsel for BCS Properties sent an email to Christopher Civil, the
 10 attorney at Raj Abhyanker P.C. who served the Third Party Objections, requesting that Raj
 11 Abhyanker P.C. clarify, consistent with Federal Rule of Civil Procedure 34, whether responsive
 12 documents actually are being withheld on the basis of Raj Abhyanker P.C.’s objections. In the
 13 same email, counsel for BCS Properties also requested an opportunity to meet and confer
 14 regarding the parties’ discovery dispute and informed Raj Abhyanker P.C. of BCS Properties’
 15 intention to file a motion to compel if the firm maintained its apparent position that it has no
 16 obligation to produce any documents in response to BCS Properties’ subpoena. *Id.* ¶ 16, Ex. O.
 17 Counsel for BCS Properties received a response to the foregoing email from Raj Abhyanker on
 18 July 14, 2016, *id.* ¶ 17, Ex. P, in which Raj Abhyanker P.C. refused to provide the subpoenaed
 19 documents or a privilege log or to state whether any documents not subject to a claim of privilege
 20 had been withheld. Accordingly, BCS Properties proceeded to file the instant motion.

21 ARGUMENT

22 Pursuant to Federal Rule of Civil Procedure 37(a)(1), a party may move for an order
 23 compelling discovery on notice to other parties and after conferring with the non-producing party
 24 in a good faith attempt to obtain the discovery without court intervention. Federal Rule of Civil
 25 Procedure 45(d)(2)(B)(i) relatedly provides that “[a]t any time, on notice to the commanded
 26 person, the serving party may move the court for the district where compliance is required for an
 27 order compelling production or inspection.” Here, an order is appropriate compelling Raj
 28 Abhyanker P.C. to produce the subpoenaed documents that it apparently is withholding based on

improper claims of confidentiality, work product protection, and/or attorney-client privilege.

As detailed above, counsel for BCS Properties made a good faith attempt to confer with Raj Abhyanker P.C. regarding the instant discovery dispute and provided notice of BCS Properties' intention to file this motion in the event that the firm continued to maintain that it need not produce the subpoenaed documents. In an email dated July 13, 2016, counsel for BCS Properties specifically asked that Raj Abhyanker P.C. clarify whether it was withholding documents responsive to BCS Properties' subpoena and requested an opportunity to meet and confer regarding the parties' discovery disagreement. The same email informed Raj Abhyanker P.C. that BCS Properties would move the Court for an order compelling production of the subpoenaed documents if the firm maintained its position against production. Hollman Decl. ¶ 16, Ex. O. On July 14, 2016, Raj Abhyanker sent an email response to counsel for BCS Properties refusing to provide the subpoenaed documents or a privilege log or to state whether any documents not subject to a claim of privilege had been withheld. *Id.* ¶ 17, Ex. P.

Raj Abhyanker P.C.'s objections to BCS Properties' document requests also are unavailing on the merits, and the Firm should be compelled to produce the subpoenaed materials. The parties' arguments largely are the same as to each of BCS Properties' individual document requests but are reiterated separately below as to each, in compliance with Local Rule 37-2.

BCS Properties' Request for Production No. 1: "All documents that comprise the client file of Lile Inc. relating to the domain name registration and trademark application for 'CFBPLAYOFF.COM,' 'COLLEGEFOOTBALLPLAYOFF.COM,' 'COLLEGEBOWLPLAYOFF.COM,' and any related mark."

Objection: "Raj Abhyanker P.C. objects to this request on the ground that it is overly broad, unduly burdensome, vague, ambiguous, and not reasonably specific. Moreover, this request encompasses communications that are irrelevant and not reasonably calculated to [lead to] the discovery of admissible evidence. Raj Abhyanker P.C. further objects to this request to the extent that Defendant seeks confidential business and financial information and/or trade secrets and communications that are subject to the attorney-client privilege, the work product doctrine,

1 the work product doctrine [sic], or any other applicable privilege or limitation on discovery.
 2 Subject to and without waiving the General Objections and the foregoing specific objections, Raj
 3 Abhyanker P.C. responds that there are no responsive, non-privileged documents in Raj
 4 Abhyanker P.C.'s possession, custody, or control that are responsive to this specific request"
 5 (hereinafter "Raj Abhyanker P.C.'s Standard Objection," as Raj Abhyanker P.C. reproduced the
 6 foregoing specific objection verbatim as to each document request propounded by BCS
 7 Properties).

8 **Response:**

9 Raj Abhyanker P.C.'s general and boilerplate objections that BCS Properties' Requests
 10 for Production Nos. 1-6 are "overly broad, unduly burdensome, vague, ambiguous, and not
 11 reasonably specific," and that they "encompass[] communications that are irrelevant and not
 12 reasonably calculated to [lead to] the discovery of admissible evidence," are not consistent with
 13 the recent amendments to the Federal Rules of Civil Procedure and should be rejected. Parties
 14 responding to discovery requests now must state their objections "with specificity" and clarify
 15 whether responsive materials actually are being withheld on the basis of the objections. *See* Fed.
 16 R. Civ. P. 34(b)(2)(B), 34 (b)(2)(C). The foregoing objections plainly fail to clarify whether Raj
 17 Abhyanker P.C. actually is withholding responsive documents and are stated entirely without
 18 specificity. Federal Rule of Civil Procedure 34(b)(2)(C) also instructs that a responding entity is
 19 to "specify the part" of the request to which it objects and "permit inspection of the rest" of the
 20 materials not withheld from production. Raj Abhyanker P.C.'s vague objections appear to deny
 21 BCS Properties any opportunity to inspect responsive documents not subject to objection, or any
 22 practical ability to determine whether such documents exist. For the sake of brevity, BCS
 23 Properties requests that the Court consider the foregoing response incorporated in identical terms
 24 as to each of its Requests for Production Nos. 2-6 below.

25 Raj Abhyanker P.C.'s objection that BCS Properties' Request for Production No. 1 seeks
 26 "confidential business and financial information and/or trade secrets and communications that are
 27 subject to the attorney-client privilege, the work product doctrine, the work product doctrine [sic],
 28 or any other applicable privilege or limitation on discovery" also lacks merit. As an initial matter,

1 an entity withholding subpoenaed information under a claim that it is privileged or subject to
2 protection as trial-preparation material must (1) expressly make the claim, and (2) describe the
3 nature of the withheld documents, communications, or tangible things in a manner that, without
4 revealing information itself privileged or protected, will enable the parties to assess the claim.”
5 Fed. R. Civ. P. 45(e)(2)(A). Raj Abhyanker P.C. did not produce a privilege log in compliance
6 with Federal Rule of Civil Procedure 45 or provide any other details regarding its apparent
7 decision to withhold subpoenaed documents pursuant to its vague assertions of confidentiality,
8 work product protection, and/or attorney-client privilege. At the very least, Raj Abhyanker P.C.
9 should be compelled to produce an appropriate privilege log so that the parties may assess the
10 merits of any of the Firm’s privilege claims.

11 To the extent that Raj Abhyanker P.C. has suggested that its client file responsive to BCS
12 Properties’ Request for Production No. 1 is shielded from compelled disclosure as attorney work
13 product, it has provided no information to substantiate whether any documents in that file actually
14 contain or constitute attorney work product. Moreover, BCS Properties’ document requests seek
15 to discover the *factual basis* for the statements contained in Falleiro’s declaration supporting
16 Application Serial No. 86052371. Those facts are not, in and of themselves, properly subject to
17 any privilege or protection.

18 Raj Abhyanker P.C.’s suggestion that its client file for Lile is subject to attorney-client
19 privilege also is unavailing. Because attorney-client privilege “has the effect of withholding
20 relevant information from the fact-finder, it applies only where necessary to achieve its purpose.”
21 *Fisher v. United States*, 425 U.S. 391, 403 (1976); *see also Weil v. Investment/Indicators*,
22 *Research and Mgmt, Inc.*, 647 F.2d 18, 24 (9th Cir. 1981) (because the attorney-client privilege
23 “impedes full and free discovery of the truth,” it is “strictly construed”). In addition,
24 “communications between client and attorney for the purpose of relaying communications to a
25 third party [are] not protected by the attorney-client privilege.” *United States v. Bergonzi*, 216
26 F.R.D. 487, 493 (N.D. Cal. 2003); *United States v. Sudikoff*, 36 F.Supp. 2d 1196, 1204 (C.D. Cal.
27 1999). “[V]oluntary disclosure of the content of a privileged attorney communication constitutes
28 waiver of the privilege as to all other such communications on the same subject.” *Weil*, 647 F.2d

1 at 24; *United States ex rel. Parikh v. Premera Blue Cross*, 2006 WL 6654604, * 1 (W.D. Wash.
 2 Oct. 31, 2006); *see also United States v. Bump*, 605 F.2d 548, 551 (10th Cir. 1979) (“When a
 3 matter is communicated to the lawyer with the intention or understanding it is to be repeated to
 4 another, the content of the statement is not within the privilege.”).

5 A trademark application is required to include a statement that is verified by the applicant
 6 or by someone who is authorized to verify facts on behalf of an applicant. *See* 15 U.S.C. §§
 7 1051(a)(3), 1051(b)(3); 37 C.F.R. §§2.32(b), 2.33(a), 2.19(e)(1). The signer must make a
 8 reasonable inquiry under the circumstances and certify, among other matters, that the factual
 9 contentions are true and that they have (or likely have) evidentiary support. To the extent that
 10 any information contained in Lile’s client file was disclosed to – or was intended for use by Raj
 11 Abhyanker P.C. attorneys in connection with disclosures to – the U.S. Patent and Trademark
 12 Office or any other third parties, it does not qualify as privileged and must be disclosed.

13 Moreover, Falleiro’s declaration supporting Lile’s Application Serial No. 86052371
 14 attested to Opposer’s entitlement to use the “CFBPLAYOFF.COM” mark, based on “her own
 15 knowledge.” By its own terms, Falleiro’s declaration placed her personal knowledge directly at
 16 issue in this case. Any information upon which she relied in submitting her declaration cannot be
 17 subject to a legitimate claim of privilege. *See Hearn v. Rhay*, 68 F.R.D. 574, 581 (E.D. Wash.
 18 1975) (collecting cases and explaining that a court “should find that the party asserting a privilege
 19 has impliedly waived it through his own affirmative conduct” where “(1) assertion of the
 20 privilege was a result of some affirmative act, such as filing suit, by the asserting party; (2)
 21 through this affirmative act, the asserting party put the protected information at issue by making it
 22 relevant to the case; and (3) application of the privilege would have denied the opposing party
 23 access to information vital to his defense”); *Intellect Wireless, Inc. v. HTC Corp.*, 2014 WL
 24 1797488 * 2 (N.D. Ill. 2014) (finding attorney-client privilege waived as to inventor’s
 25 communications with trial counsel, where inventor filed a false declaration with the U.S. Patent
 26 and Trademark Office with the knowledge of prosecuting counsel, who in turn advised the
 27 inventor to communicate with trial counsel about the matter).

28 In any event, a party asserting attorney-client privilege has the burden of demonstrating

1 the applicability of the privilege. *See, e.g., Eden Isle Marina, Inc. v. U.S.*, 89 Fed. Cl. 480, 496
 2 (Fed. Cl. 2009) (citations omitted). Raj Abhyanker P.C. hardly has engaged that task. Indeed, as
 3 noted above, it has failed even to identify and claim any portions of its client file for Lile that may
 4 be subject to claims of privilege.

5 Finally, the client file requested pursuant to BCS Properties' Request for Production No. 1
 6 constitutes relevant evidence related to the claims and defenses of Lile and BCS Properties in the
 7 TTAB Proceeding. As discussed above, given the apparent spoliation of Lile's early website
 8 evidence, the only remaining sources of evidentiary information regarding Lile's use priority (if
 9 any) would seem to be Lile's client file from Raj Abhyanker P.C. and Falleiro's deposition
 10 testimony. Lile has confirmed that it has no other responsive documents to produce and has not
 11 identified any other witnesses. Hollman Decl. ¶ 19. Accordingly, BCS Properties' request for
 12 Lile's client file is proportional to the needs of the case, considering the importance of the issues
 13 at stake in the TTAB Proceeding, the amount in controversy, the parties' relative access to
 14 relevant information (particularly given Lile's continued refusal to comply with its discovery
 15 obligations), the parties' resources, the importance of the requested discovery in resolving the
 16 issues in the TTAB proceeding, and the burden and expense of the requested discovery as against
 17 its likely benefit in the case. Fed. R. Civ. P. 26(b)(1). An order compelling Raj Abhyanker P.C.
 18 to produce its client file for Lile in response to BCS Properties' subpoena is fully warranted.

19
 20 **BCS Properties' Request for Production No. 2:** "All documents relied on in any way by
 21 Tanya Falleiro for any of the statements made in her declaration filed August 30, 2013, to support
 22 the Application Serial No. 86052371, including any documents which constitute, reflect or relate
 23 to communications with any representative of Lile Inc. relating to the use of the mark, the
 24 applicant's entitlement to use the mark in commerce, and the basis for the belief that no other
 25 person, firm, corporation or association had the right to use the mark in commerce."

26 **Objection:** Raj Abhyanker P.C.'s Standard Objection.

27 **Response:** BCS Properties' arguments in response to Raj Abhyanker P.C.'s Standard
 28 Objection largely are the same with respect to Request for Production No. 2 as with respect to

1 Request for Production No. 1.

2 Briefly, Raj Abhyanker P.C.'s objection that BCS Properties' Request for Production No.
3 2 seeks confidential or privilege materials lacks merit. An entity withholding subpoenaed
4 information under a claim that it is privileged or subject to work product protection must (1)
5 expressly make the claim, and (2) describe the nature of the withheld material to enable the
6 parties to assess the claim. Fed. R. Civ. P. 45(e)(2)(A). Raj Abhyanker P.C. did not produce a
7 privilege log or other details regarding its apparent decision to withhold subpoenaed documents
8 pursuant to its vague assertions of confidentiality, work product protection, and/or attorney-client
9 privilege. At the very least, Raj Abhyanker P.C. should be compelled to produce an appropriate
10 privilege log.

11 To the extent that Raj Abhyanker P.C. has suggested that documents responsive to BCS
12 Properties' Request for Production No. 2 are shielded from compelled disclosure as attorney work
13 product, it has provided no information to substantiate whether any such documents actually may
14 be considered attorney work product. In any event, BCS Properties seeks to discover the *factual*
15 *basis* for the statements contained in Falleiro's declaration supporting Application Serial No.
16 86052371. Those facts are not properly subject to any privilege or protection.

17 Raj Abhyanker P.C.'s claim of attorney-client privilege as to documents responsive to
18 BCS Properties' Request for Production No. 2 also is unavailing. "[C]ommunications between
19 client and attorney for the purpose of relaying communications to a third party [are] not protected
20 by the attorney-client privilege." *Bergonzi*, 216 F.R.D. at 493; *Sudikoff*, 36 F.Supp. 2d at
21 1204. "[V]oluntary disclosure of the content of a privileged attorney communication constitutes
22 waiver of the privilege as to all other such communications on the same subject." *Weil*, 647 F.2d
23 at 24; *United States ex rel. Parikh*, 2006 WL 6654604 at * 1. To the extent that any information
24 contained in Lile's client file was disclosed to – or was intended for use by Raj Abhyanker P.C.
25 attorneys in connection with disclosures to – the U.S. Patent and Trademark Office or any other
26 third parties, it does not qualify as privileged and must be disclosed.

27 Moreover, Falleiro's declaration supporting Lile's Application Serial No. 86052371
28 attested to Opposer's entitlement to use the "CFBPLAYOFF.COM" mark, based on "her own

knowledge.” By its own terms, Falleiro’s declaration placed her personal knowledge directly at issue in this case. Any information upon which she relied in submitting her declaration cannot be subject to a legitimate claim of privilege. *See Hearn*, 68 F.R.D. at 581; *Intellect Wireless*, 2014 WL 1797488 at * 2. In any event, Raj Abhyanker P.C. has not sustained *its* burden to establish attorney-client privilege in this instance. *See, e.g., Eden Isle Marina*, 89 Fed. Cl. at 496.

Finally, the documents requested in BCS Properties’ Request for Production No. 2 constitute relevant evidence related to the claims and defenses of Lile and BCS Properties in the TTAB Proceeding. As discussed above, given the apparent spoliation of Lile’s early website evidence, the only remaining sources of evidentiary information regarding Lile’s use priority (if any) would seem to be Lile’s client file from Raj Abhyanker P.C. and Falleiro’s deposition testimony. Lile has confirmed that it has no other responsive documents to produce and has not identified any other witnesses. Hollman Decl. ¶ 19. Accordingly, BCS Properties’ Request for Production No. 2 is proportional to the needs of the case. Fed. R. Civ. P. 26(b)(1).

BCS Properties’ Request for Production No. 3: “Your engagement letter with Lile Inc.”

Objection: Raj Abhyanker P.C.’s Standard Objection.

Response: BCS Properties’ arguments in response to Raj Abhyanker P.C.’s Standard Objection largely are the same with respect to Request for Production No. 3 as with respect to Request for Production No. 1.

Briefly, Raj Abhyanker P.C.’s objection that BCS Properties’ Request for Production No. 3 seeks confidential or privilege materials lacks merit. An entity withholding subpoenaed information under a claim that it is privileged or subject to work product protection must (1) expressly make the claim, and (2) describe the nature of the withheld material to enable the parties to assess the claim. Fed. R. Civ. P. 45(e)(2)(A). Raj Abhyanker P.C. did not produce a privilege log or other details regarding its apparent decision to withhold subpoenaed documents pursuant to its vague assertions of confidentiality, work product protection, and/or attorney-client privilege. At the very least, Raj Abhyanker P.C. should be compelled to produce an appropriate privilege log.

1 To the extent that Raj Abhyanker P.C. has suggested that documents responsive to BCS
 2 Properties' Request for Production No. 3 are shielded from compelled disclosure as attorney work
 3 product, it has provided no information to substantiate whether any such documents actually may
 4 be considered attorney work product. Indeed, such a claim seems unlikely with respect to an
 5 engagement letter. In any event, BCS Properties' Request for Production No. 3 supports its
 6 attempt to discover the *factual basis* for the statements contained in Falleiro's declaration
 7 supporting Application Serial No. 86052371, including any information contained in Raj
 8 Abhyanker P.C.'s engagement letter to Lile. Those facts are not properly subject to any privilege
 9 or protection.

10 Raj Abhyanker P.C.'s claim of attorney-client privilege as to documents responsive to
 11 BCS Properties' Request for Production No. 3 also is unavailing. As an initial matter, the
 12 engagement letter requested through BCS Properties' subpoena presumably did not contain legal
 13 advice, an engagement letter normally being designed to establish the terms of representation
 14 prior to the provision of legal advice to clients. Moreover, "communications between client and
 15 attorney for the purpose of relaying communications to a third party [are] not protected by the
 16 attorney-client privilege." *Bergonzi*, 216 F.R.D. at 493; *Sudikoff*, 36 F.Supp. 2d at
 17 1204. "[V]oluntary disclosure of the content of a privileged attorney communication constitutes
 18 waiver of the privilege as to all other such communications on the same subject." *Weil*, 647 F.2d
 19 at 24; *United States ex rel. Parikh*, 2006 WL 6654604 at * 1. To the extent that any information
 20 contained in Lile's client file was disclosed to – or was intended for use by Raj Abhyanker P.C.
 21 attorneys in connection with disclosures to – the U.S. Patent and Trademark Office or any other
 22 third parties, it does not qualify as privileged and must be disclosed. This includes any
 23 responsive information contained in Raj Abhyanker P.C.'s engagement letter to Lile.

24 Falleiro's declaration supporting Lile's Application Serial No. 86052371 also attested to
 25 Opposer's entitlement to use the "CFBPLAYOFF.COM" mark, based on "her own knowledge."
 26 By its own terms, Falleiro's declaration placed her personal knowledge directly at issue in this
 27 case. Any information upon which she relied in submitting her declaration cannot be subject to a
 28 legitimate claim of privilege. *See Hearn*, 68 F.R.D. at 581; *Intellect Wireless*, 2014 WL 1797488

1 at * 2. Again, this includes any information contained in Raj Abhyanker P.C.'s engagement letter
 2 to Lile. In any event, Raj Abhyanker P.C. has not sustained *its* burden to establish attorney-client
 3 privilege in this instance. *See, e.g., Eden Isle Marina*, 89 Fed. Cl. at 496.

4 Finally, the documents requested in BCS Properties' Request for Production No. 3
 5 constitute relevant evidence related to the claims and defenses of Lile and BCS Properties in the
 6 TTAB Proceeding. As discussed above, given the apparent spoliation of Lile's early website
 7 evidence, the only remaining sources of evidentiary information regarding Lile's use priority (if
 8 any) would seem to be Lile's client file from Raj Abhyanker P.C. and Falleiro's deposition
 9 testimony. Lile has confirmed that it has no other responsive documents to produce and has not
 10 identified any other witnesses. Hollman Decl. ¶ 19. Accordingly, BCS Properties' Request for
 11 Production No. 3 is proportional to the needs of the case. Fed. R. Civ. P. 26(b)(1).

12
 13 **BCS Properties' Request for Production No. 4:** "Your billing records relating to your
 14 work on behalf of Lile Inc. relating to the marks 'CFBPLAYOFF.COM,'
 15 'COLLEGEFOOTBALLPLAYOFF.COM,' 'COLLEGEBOWLPLAYOFF.COM,' and any
 16 related mark."

17 **Objection:** Raj Abhyanker P.C.'s Standard Objection.

18 **Response:** BCS Properties' arguments in response to Raj Abhyanker P.C.'s Standard
 19 Objection largely are the same with respect to Request for Production No. 4 as with respect to
 20 Request for Production No. 1.

21 Briefly, Raj Abhyanker P.C.'s objection that BCS Properties' Request for Production No.
 22 4 seeks confidential or privilege materials lacks merit. An entity withholding subpoenaed
 23 information under a claim that it is privileged or subject to work product protection must (1)
 24 expressly make the claim, and (2) describe the nature of the withheld material to enable the
 25 parties to assess the claim. Fed. R. Civ. P. 45(e)(2)(A). Raj Abhyanker P.C. did not produce a
 26 privilege log or other details regarding its apparent decision to withhold subpoenaed documents
 27 pursuant to its vague assertions of confidentiality, work product protection, and/or attorney-client
 28 privilege. At the very least, Raj Abhyanker P.C. should be compelled to produce an appropriate

1 privilege log.

2 To the extent that Raj Abhyanker P.C. has suggested that documents responsive to BCS
3 Properties' Request for Production No. 4 are shielded from compelled disclosure as attorney work
4 product, it has provided no information to substantiate whether any such documents actually may
5 be considered attorney work product. Indeed, such a claim seems unlikely with respect to client
6 billing records. In any event, BCS Properties' Request for Production No. 3 supports its attempt
7 to discover the *factual basis* for the statements contained in Falleiro's declaration supporting
8 Application Serial No. 86052371, including any information contained in Raj Abhyanker P.C.'s
9 billing records for work performed on behalf of Lile. Those facts are not properly subject to any
10 privilege or protection.

11 Raj Abhyanker P.C.'s claim of attorney-client privilege as to documents responsive to
12 BCS Properties' Request for Production No. 4 also is unavailing. As an initial matter, the billing
13 records requested in BCS Properties' subpoena presumably did not themselves contain legal
14 advice; if so, Raj Abhyanker P.C. has not undertaken to explain what legal advice they contain.
15 Moreover, "communications between client and attorney for the purpose of relaying
16 communications to a third party [are] not protected by the attorney-client privilege." *Bergonzi*,
17 216 F.R.D. at 493; *Sudikoff*, 36 F.Supp. 2d at 1204. "[V]oluntary disclosure of the content of a
18 privileged attorney communication constitutes waiver of the privilege as to all other such
19 communications on the same subject." *Weil*, 647 F.2d at 24; *United States ex rel. Parikh*, 2006
20 WL 6654604 at * 1. To the extent that any information contained in Lile's client file was
21 disclosed to – or was intended for use by Raj Abhyanker P.C. attorneys in connection with
22 disclosures to – the U.S. Patent and Trademark Office or any other third parties, it does not
23 qualify as privileged and must be disclosed. This includes any responsive information contained
24 in Raj Abhyanker P.C.'s billing records for Lile.

25 Falleiro's declaration supporting Lile's Application Serial No. 86052371 also attested to
26 Opposer's entitlement to use the "CFBPLAYOFF.COM" mark, based on "her own knowledge."
27 By its own terms, Falleiro's declaration placed her personal knowledge directly at issue in this
28 case. Any information upon which she relied in submitting her declaration cannot be subject to a

1 legitimate claim of privilege. *See Hearn*, 68 F.R.D. at 581; *Intellect Wireless*, 2014 WL 1797488
 2 at * 2. Again, this includes any information contained in Raj Abhyanker P.C.'s billing records for
 3 Lile. In any event, Raj Abhyanker P.C. has not sustained *its* burden to establish attorney-client
 4 privilege in this instance. *See, e.g., Eden Isle Marina*, 89 Fed. Cl. at 496.

5 Finally, the documents requested in BCS Properties' Request for Production No. 4
 6 constitute relevant evidence related to the claims and defenses of Lile and BCS Properties in the
 7 TTAB Proceeding. As discussed above, given the apparent spoliation of Lile's early website
 8 evidence, the only remaining sources of evidentiary information regarding Lile's use priority (if
 9 any) would seem to be Lile's client file from Raj Abhyanker P.C. and Falleiro's deposition
 10 testimony. Lile has confirmed that it has no other responsive documents to produce and has not
 11 identified any other witnesses. Hollman Decl. ¶ 19. Accordingly, BCS Properties' Request for
 12 Production No. 4 is proportional to the needs of the case. Fed. R. Civ. P. 26(b)(1).

13
 14 **BCS Properties' Request for Production No. 5:** "All documents relating to any use by
 15 Lile of the foregoing marks or domain names."

16 **Objection:** Raj Abhyanker P.C.'s Standard Objection.

17 **Response:** BCS Properties' arguments in response to Raj Abhyanker P.C.'s Standard
 18 Objection largely are the same with respect to Request for Production No. 5 as with respect to
 19 Request for Production No. 1.

20 Briefly, Raj Abhyanker P.C.'s objection that BCS Properties' Request for Production No.
 21 5 seeks confidential or privileged materials lacks merit. An entity withholding subpoenaed
 22 information under a claim that it is privileged or subject to work product protection must "(1)
 23 expressly make the claim, and (2) describe the nature of the withheld material to enable the
 24 parties to assess the claim. Fed. R. Civ. P. 45(e)(2)(A). Raj Abhyanker P.C. did not produce a
 25 privilege log or other details regarding its apparent decision to withhold subpoenaed documents
 26 pursuant to its vague assertions of confidentiality, work product protection, and/or attorney-client
 27 privilege. At the very least, Raj Abhyanker P.C. should be compelled to produce an appropriate
 28 privilege log.

To the extent that Raj Abhyanker P.C. has suggested that documents responsive to BCS Properties' Request for Production No. 5 are shielded from compelled disclosure as attorney work product, it has provided no information to substantiate whether any such documents actually may be considered attorney work product. In any event, BCS Properties' Request for Production No. 5 supports its attempt to discover the *factual basis* for the statements contained in Falleiro's declaration supporting Application Serial No. 86052371, including information in documents related to Lile's use of relevant marks or domain names. Those facts are not properly subject to any privilege or protection.

Raj Abhyanker P.C.'s claim of attorney-client privilege as to documents responsive to BCS Properties' Request for Production No. 5 also is unavailing. "[C]ommunications between client and attorney for the purpose of relaying communications to a third party [are] not protected by the attorney-client privilege." *Bergonzi*, 216 F.R.D. at 493; *Sudikoff*, 36 F.Supp. 2d at 1204. "[V]oluntary disclosure of the content of a privileged attorney communication constitutes waiver of the privilege as to all other such communications on the same subject." *Weil*, 647 F.2d at 24; *United States ex rel. Parikh*, 2006 WL 6654604 at * 1. To the extent that any information contained in Lile's client file was disclosed to – or was intended for use by Raj Abhyanker P.C. attorneys in connection with disclosures to – the U.S. Patent and Trademark Office or any other third parties, it does not qualify as privileged and must be disclosed. This includes any responsive information contained in documents related to Lile's use of relevant marks or domain names.

Falleiro's declaration supporting Lile's Application Serial No. 86052371 also attested to Opposer's entitlement to use the "CFBPLAYOFF.COM" mark, based on "her own knowledge." By its own terms, Falleiro's declaration placed her personal knowledge directly at issue in this case. Any information upon which she relied in submitting her declaration cannot be subject to a legitimate claim of privilege. *See Hearn*, 68 F.R.D. at 581; *Intellect Wireless*, 2014 WL 1797488 at * 2. Again, this includes any information contained in documents related to Lile's use of relevant marks or domain names. In any event, Raj Abhyanker P.C. has not sustained its burden to establish attorney-client privilege in this instance. *See, e.g., Eden Isle Marina*, 89 Fed. Cl. at

1 496.

2 Finally, the documents requested in BCS Properties' Request for Production No. 5
3 constitute relevant evidence related to the claims and defenses of Lile and BCS Properties in the
4 TTAB Proceeding. As discussed above, given the apparent spoliation of Lile's early website
5 evidence, the only remaining sources of evidentiary information regarding Lile's use priority (if
6 any) would seem to be Lile's client file from Raj Abhyanker P.C. and Falleiro's deposition
7 testimony. Lile has confirmed that it has no other responsive documents to produce and has not
8 identified any other witnesses. Hollman Decl. ¶ 19. Accordingly, BCS Properties' Request for
9 Production No. 5 is proportional to the needs of the case. Fed. R. Civ. P. 26(b)(1).

10 **BCS Properties' Request for Production No. 6:** "All records of Raj Abhyanker P.C. for
11 items 1 through 5 above, as such records are maintained in the ordinary course of business."

12 **Objection:** Raj Abhyanker P.C.'s Standard Objection.

13 **Response:** BCS Properties' arguments in response to Raj Abhyanker P.C.'s Standard
14 Objection largely are the same with respect to Request for Production No. 6 as with respect to
15 Request for Production No. 1.

16 Briefly, Raj Abhyanker P.C.'s objection that BCS Properties' Request for Production No.
17 6 seeks confidential or privileged materials lacks merit. An entity withholding subpoenaed
18 information under a claim that it is privileged or subject to work product protection must "(1)
19 expressly make the claim, and (2) describe the nature of the withheld material to enable the
20 parties to assess the claim. Fed. R. Civ. P. 45(e)(2)(A). Raj Abhyanker P.C. did not produce a
21 privilege log or other details regarding its apparent decision to withhold subpoenaed documents
22 pursuant to its vague assertions of confidentiality, work product protection, and/or attorney-client
23 privilege. At the very least, Raj Abhyanker P.C. should be compelled to produce an appropriate
24 privilege log.

25 To the extent that Raj Abhyanker P.C. has suggested that documents responsive to BCS
26 Properties' Request for Production No. 6 are shielded from compelled disclosure as attorney work
27 product, it has provided no information to substantiate whether any such documents actually may
28 be considered attorney work product. In any event, BCS Properties' Request for Production No.

6 supports its attempt to discover the *factual basis* for the statements contained in Falleiro's declaration supporting Application Serial No. 86052371. Those facts are not properly subject to any privilege or protection.

Raj Abhyanker P.C.'s claim of attorney-client privilege as to documents responsive to BCS Properties' Request for Production No. 6 also is unavailing. "[C]ommunications between client and attorney for the purpose of relaying communications to a third party [are] not protected by the attorney-client privilege." *Bergonzi*, 216 F.R.D. at 493; *Sudikoff*, 36 F.Supp. 2d at 1204. "[V]oluntary disclosure of the content of a privileged attorney communication constitutes waiver of the privilege as to all other such communications on the same subject." *Weil*, 647 F.2d at 24; *United States ex rel. Parikh*, 2006 WL 6654604 at * 1. To the extent that any information contained in Lile's client file was disclosed to – or was intended for use by Raj Abhyanker P.C. attorneys in connection with disclosures to – the U.S. Patent and Trademark Office or any other third parties, it does not qualify as privileged and must be disclosed.

Falleiro's declaration supporting Lile's Application Serial No. 86052371 also attested to Opposer's entitlement to use the "CFBPLAYOFF.COM" mark, based on "her own knowledge." By its own terms, Falleiro's declaration placed her personal knowledge directly at issue in this case. Any information upon which she relied in submitting her declaration cannot be subject to a legitimate claim of privilege. *See Hearn*, 68 F.R.D. at 581; *Intellect Wireless*, 2014 WL 1797488 at * 2. In any event, Raj Abhyanker P.C. has not sustained *its* burden to establish attorney-client privilege in this instance. *See, e.g., Eden Isle Marina*, 89 Fed. Cl. at 496.

Finally, the documents requested in BCS Properties' Request for Production No. 6 constitute relevant evidence related to the claims and defenses of Lile and BCS Properties in the TTAB Proceeding. As discussed above, given the apparent spoliation of Lile's early website evidence, the only remaining sources of evidentiary information regarding Lile's use priority (if any) would seem to be Lile's client file from Raj Abhyanker P.C. and Falleiro's deposition testimony. Lile has confirmed that it has no other responsive documents to produce and has not identified any other witnesses. Hollman Decl. ¶ 19. Accordingly, BCS Properties' Request for Production No. 6 is proportional to the needs of the case. Fed. R. Civ. P. 26(b)(1).

CONCLUSION

For the reasons set forth above, the Third Party Objections are unwarranted by the facts of this case and unsupported by the case law. They also fail to provide the supporting information required under the Federal Rules of Civil Procedure and were unaccompanied by an appropriate privilege log. BCS Properties therefore respectfully requests that the Court enter an order (1) compelling Raj Abhyanker P.C. to produce all documents requested pursuant to BCS Properties' June 28, 2016 subpoena duces tecum, and (2) for any documents as to which Raj Abhyanker P.C. persists in claiming privilege, compelling Raj Abhyanker P.C. to produce an appropriate privilege log compliant with the requirements of Federal Rule of Civil Procedure 45(e)(2)(A).

Dated: July 15, 2016

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on July 15, 2016 I filed the foregoing MOTION TO COMPEL PRODUCTION OF DOCUMENTS with the Clerk of the Court and caused a copy of the same document to be served by first-class mail, postage prepaid, on:

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